

**Attorney Docket No. 103864-700RI1****PATENT****REMARKS**

In the Office Action, the Examiner noted that claims 1-4, 6, 8-14, 16, 18-31, 33-44, 46-59, 61-76, 78-90, 114, 115, 118-123, 148, 149, 153-162 and 164-218 are pending in the application, that claims 166-218 are withdrawn from consideration, **that claims 16, 18-31, 33-44, 46-59, 61-76, 78-90, 114, 115, 118-123, 148, 149, 153-162, 164 and 165 are allowed**, and that claims 1-4, 6, and 8-14 are rejected.

Applicants appreciate the Examiner's indication of **allowed claims 16, 18-31, 33-44, 46-59, 61-76, 78-90, 114, 115, 118-123, 148, 149, 153-162, 164 and 165**. Claims 166-218 have been cancelled as being directed to a separate invention.

Applicants incorporate herein by reference the remarks contained in Applicants' responses filed on November 26, 2003, August 11, 2003, September 30, 2002, and July 29, 2002. Applicants submit that the combination of elements and/or steps recited in each presently pending claim, when interpreted as a whole, is patentable over any combination of Charhut, Bailer and Goldberg.

**Response to Specific Points in Office Action Dated June 10, 2004**

The Examiner states that customized literature packs are well known in the art as taught by Charhut. The Examiner further states that customization is a matter of design choice. Applicant disagrees. In particular, the claims recite the combination of elements including "literature packs customized to said prescription orders." As explained below, Charhut does not customize the literature packs "to said prescription orders." Applicant does not agree that customization is a matter of design choice. Accordingly, Applicant requests the Examiner to provide a prior art reference or an affidavit providing a detailed explanation under 37 C.F.R. Section 1.104(d)(2) regarding customization as currently claimed so that Applicant can fully respond to the Examiner's reasoning. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

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The Examiner also states that "bottle identifiers as applied to the bottles in claim 3 solves no stated problem since the prior art applies to label equivalents." Applicant disagrees, particularly because the prior art does not show the claimed features, in combination, of "the literature pack and each prescription bottle having an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack." Although there is no requirement that a claim recite a solution to a problem, the present claims clearly recite that the respective identifiers are used to match the prescription order with the corresponding literature pack. Applicant does not agree with the Examiner that the use of identifiers is a matter of design choice. Accordingly, Applicant requests the Examiner to provide a prior art reference or an affidavit providing a detailed explanation under 37 C.F.R. Section 1.104(d)(2) regarding why the use of identifiers as claimed is a matter of design choice so that Applicant can fully respond to the Examiner's reasoning. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

The Examiner further states that the use of carriers is duplication and/or merely compartmentalization. Applicant disagrees. Again, what is specifically being claimed in combination is "means to load prescription bottles corresponding to the prescriptions of said orders into scheduled locations in said carriers." This claimed feature, in combination, is not merely duplication because the relevant claims recite "scheduled locations." The Examiner has not cited any prior art that is related to this feature, in combination. Accordingly, Applicant requests the Examiner to provide a prior art reference or an affidavit providing a detailed explanation under 37 C.F.R. Section 1.104(d)(2) regarding why the use of identifiers as claimed is a matter of design choice so that Applicant can fully respond to the Examiner's reasoning. In the absence of either, Applicant requests the Examiner to withdraw the rejection.

**Response to Specific Claim Combinations****A. Claims 1-3**

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Independent claim 1 recites a combination of features directed to an automatic prescription filling and dispensing system. As recited by claim 1, the system comprises, inter alia, "one or more pill dispensing machines to automatically count out and dispense pills into two or more prescription bottles in accordance with prescription orders." The system also comprises "means to print literature packs customized to said prescription orders." In addition, the system comprises a "bagger that present a shipping container for each prescription order." Claim 1 also includes:

"a computer responsive to the prescription orders to provide prescription bottles filled with pharmaceuticals in accordance with the prescriptions of said prescription orders, and order consolidation means comprising means to print literature packs customized to said prescription orders, an assembly station to assemble the order at said order consolidation and packing station, a bottle removing mechanism that removes the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container, and a bagger machine that presents a shipping container for each prescription order, the shipping container receiving one or more prescription bottles for each prescription order"

Finally, claim 1 recites that the literature pack and each prescription bottle have "an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack." This combination of features recited in claim 1, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without conceding that any reference discloses or suggests any of the elements recited in claim 1, each reference absolutely fails to teach or suggest, in addition, at least the feature of printing a literature pack customized to a prescription order, or the feature of a literature pack being inserted "separately" from a bottle for a prescription order. In fact, none of these references disclose *anything* with regard to a literature pack being associated with a bottle of a prescription order. In this regard, Bailer discloses a generic literature package being inserted into a pocket or holder (see, e.g., col. 4, lines 21-23),

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and has nothing to do with printing literature packages, let alone printing "literature packs customized to said prescription orders," as recited in the claimed invention. In this regard, Charhut also does not teach or suggest that the literature pack and each prescription bottle have "an identifier identified by at least one identification system to ensure that the shipping container contains the one or more prescription bottles for the prescription order and the corresponding literature pack." Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. For example, none of the prior art references show or suggest the combination of features including "a computer responsive to the prescription orders to provide prescription bottles filled with pharmaceuticals in accordance with the prescriptions of said prescription orders, and order consolidation means comprising means to print literature packs customized to said prescription orders, an assembly station to assemble the order at said order consolidation and packing station, a bottle removing mechanism that removes the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container, and a bagger machine that presents a shipping container for each prescription order, the shipping container receiving one or more prescription bottles for each prescription order." Finally, since several features are missing, the combination of features is also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 2-3 are not only allowable by virtue of their dependency from independent claim 1, but also because of additional features they recite. Claim 3, for example, recites, "the bottle identifiers are applied to said prescription bottles prior to dispensing pharmaceuticals into the bottles," which is not taught or suggested by Charhut, Bailer or Goldberg. In fact, Charhut teaches away from the claimed invention in this regard insofar as Charhut teaches that vials are labeled "during or immediately following filling." (col. 4, lines 1-4).

In view of the above, Applicants submit that the combination of features recited in each of claims 1-3 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 1-3 be passed to issue.

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Independent claim 4 recites a combination of features directed to a prescription filling and dispensing system. As recited by claim 4, the system comprises, inter alia, "a prescription dispensing and packing system comprising a plurality of bottle carriers each having receptacles to receive a plurality of pill bottles, means to receive orders for prescriptions, means to load prescription bottles corresponding to the prescriptions of said orders into scheduled locations in said carriers, a prescription pill dispensing machine, and means to transport said carriers with said prescription bottles through said dispensing machine." The dispensing machine dispenses "the pills of said orders into the bottles in said carriers in accordance with the scheduled locations of the pill bottles in said carriers." The "order consolidation means receiving carriers from said dispensing machine and presenting shipping containers to be filled, each shipping container corresponding to an order, said order consolidation means unloading bottles from said carriers, printing a literature pack corresponding to prescription orders, and loading one or more bottles and a corresponding literature pack into shipping containers corresponding to the orders." The "order consolidation means determining each bottle to go in each shipping container from the scheduled location of such bottle in a carrier, the literature pack and each prescription bottle having an identifier identified by at least one identification system to ensure that the shipping container contains the one or more bottles corresponding to the prescription order and the corresponding literature pack." In addition, the "order consolidation means comprises an assembly mechanism to receive a plurality of said carriers, a bottle removing mechanism to unload prescription bottles from the carriers on said assembly mechanism, and means to transport the bottles unloaded from the carriers into shipping containers, and said order consolidation means presents the shipping container for each prescription order and inserts at least one bottle for each prescription order into the shipping container and inserts the corresponding literature pack for each prescription order into the shipping container." The "order consolidation means comprises an assembly mechanism for assembling each prescription order; a bottle removing mechanism that removes the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container; and a bagging machine that receives the at least one bottle corresponding to the particular prescription order from said bottle removing mechanism and inserts the at least one bottle corresponding to the particular prescription order into the shipping container."

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Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without conceding that any reference discloses or suggests any of the elements recited in claim 4, each reference absolutely fails to teach or suggest, in addition, at least the feature of printing a literature pack customized to a prescription order, or the feature of a literature pack being inserted "separately" from a bottle for a prescription order. In fact, none of these references disclose *anything* with regard to a literature pack being associated with a bottle of a prescription order. In addition, none of the prior art references show or suggest the "The "order consolidation means comprises an assembly mechanism for assembling each prescription order; a bottle removing mechanism that removes the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container; and a bagging machine that receives the at least one bottle corresponding to the particular prescription order from said bottle removing mechanism and inserts the at least one bottle corresponding to the particular prescription order into the shipping container."

Applicants respectfully submit that dependent claims 6-7 are not only allowable by virtue of their dependency from independent claim 4, but also because of additional features they recite. Claim 6, for example, recites, "wherein said dispensing machines receive said carriers with bottles and dispense pharmaceuticals into the prescription bottles corresponding to orders in accordance with scheduled locations of said prescription bottles in said carriers, further comprising conveying means for organizing said carriers into ranks of a plurality of carriers and passing a rank of carriers through said dispensing machines synchronously, said system further comprising a plurality of said order consolidation means and conveyer means to direct all the carriers of a rank to the same order consolidation means," which is not taught or suggested by Charhut, Bailer or Goldberg.

In view of the above, Applicants submit that the combination of features recited in each of claims 4 and 6-7 are patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 4 and 6-7 be passed to issue.

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Independent claim 8 recites a combination of features directed to a system for assembling prescription orders. As recited by claim 8, the system comprises, inter alia, "a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles." The system also comprises "means for assembling a plurality of carriers, and means for removing the prescription bottles of said order from the carriers and packing the bottles of said order in a container with a corresponding customized literature pack, the customized literature pack and each prescription bottle having an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into a shipping container with the corresponding customized literature pack."

This combination of features of independent claim 8, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without conceding that Charhut, Bailer or Goldberg, disclose or suggest any of the elements recited in claim 8, each reference absolutely fails to teach or suggest, in addition, at least a prescription dispensing system having "a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles." In this regard, and as noted above, the Examiner's assertion that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes Charhut, Bailer or Goldberg, alone or in combination, teach or suggest "a multiplicity of carriers each having the capability of receiving a multiplicity of prescription bottles" as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest that the customized literature pack and each prescription bottle have "an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into a shipping container with the

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corresponding customized literature pack." Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claim 9 is not only allowable by virtue of its dependency from independent claim 8, but also because of additional features it recites. Claim 9 recites, inter alia, "means for printing the customized literature for said order." Charhut, Bailer or Goldberg, alone or in combination, do not disclose one or more printers 31 integrated with the system, as shown in Figure 2 of U.S. Patent No. 5,771,657.

In view of the above, Applicants submit that the combination of features recited in each of claims 8 and 9 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 8 and 9 be passed to issue.



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Independent claim 10 recites a combination of features directed to a system for sorting prescriptions by prescription order. As recited by claim 10, the system comprises, inter alia, "a carrier having the capability of receiving a multiplicity of prescription bottles." The system also comprises "means responsive to a prescription of an order to provide one or more prescription bottles filled with pharmaceuticals." The system comprises "an order consolidation and packing station comprising means for receiving said carrier, means for removing said one or more prescription bottles from said carrier, and means for packing said one or more prescription bottles and a corresponding customized literature pack in a container." Finally, claim 10 recites that the literature pack and each prescription bottle have "an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into the shipping container with the corresponding customized literature pack." The "order consolidation and packing station presents the shipping container for each prescription order and inserts at least one bottle for each prescription order into the shipping container and inserts the corresponding literature pack for each prescription order into the shipping container, wherein said order consolidation and packing station comprises:

- an assembly mechanism for assembling each prescription order;
- a bottle removing mechanism that removes the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container; and
- a bagging machine that receives the at least one bottle corresponding to the particular prescription order from said bottle removing mechanism and inserts the at least one bottle corresponding to the particular prescription order into the shipping container."

This combination of features of independent claim 10, when interpreted as a whole, is submitted to patentably distinguish over the prior art. Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of elements recited above. Without conceding that Charhut, Bailer or Goldberg disclose or suggest any of the elements recited in

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claim 10, each reference absolutely fails to teach or suggest at least the feature of "a carrier having the capability of receiving a multiplicity of prescription bottles in combination with the claimed order consolidation packing station." In this regard, and as noted above, the Examiner's assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes Charhut, Bailer or Goldberg, alone or in combination, teach or suggest "a carrier having the capability of receiving a multiplicity of prescription bottle" as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such carriers are disclosed.

In addition, Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest that the customized literature pack and each prescription bottle have "an identifier identified by at least one identification system to ensure that the one or more prescription bottles associated with a corresponding prescription order are inserted into the shipping container with the corresponding customized literature pack." Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claim 11 is not only allowable by virtue of its dependency from independent claim 10, but also because of additional features it recites. Claim 11 recites, inter alia, "means for printing the customized literature pack corresponding to said order." As noted above, Charhut, Bailer or Goldberg, alone or in combination, do not disclose one or more printers 31 integrated with the system, as shown in Figure 2 of U.S. 5,771,657.

In view of the above, Applicants submit that the combination of features recited in each of claims 10 and 11 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 10 and 11 be passed to issue.

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**PATENT****E. Claims 12-15**

Independent claim 12 recites a combination of features directed to method of sorting prescription bottles by prescription order. As recited in claim 12, the method comprises the step of, inter alia, "placing the one or more prescription bottles of each order in carriers, each carrier having a multiplicity of locations to receive prescription bottles." The method also comprises the step of "removing the one or more prescription bottles from the carriers in accordance with said record and placing the one or more prescription bottles and a corresponding customized literature pack of each order in a container." In addition, the method comprises the steps of "identifying one or more prescription bottles corresponding to each order," and "maintaining a record for each order of the identification of the carriers containing the one or more prescription bottles of each order." The method further comprises the steps of "assembling each prescription order, removing the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container, and receiving the at least one bottle corresponding to the particular prescription order from a bottle removing mechanism and inserting the at least one bottle corresponding to the particular prescription order into the shipping container, presenting the shipping container for each prescription order and inserting at least one bottle for each prescription order into the shipping container and inserting the corresponding literature pack for each prescription order into the shipping container." This combination of features of independent claim 12, when interpreted as a whole, is submitted to patentably distinguish over the prior art.

Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest at least the combination of steps recited above. Without conceding that Charhut, Bailer or Goldberg disclose or suggest any of the steps recited in claim 12, each reference absolutely fails to teach or suggest, for example, at least the step of "placing the one or more prescription bottles of each order in carriers, each carrier having a multiplicity of locations to receive prescription bottles," as recited in the claimed invention. In addition, the prior art also fails to teach or disclose, for example, the combination "assembling each prescription order, removing the at least one bottle corresponding to a particular prescription order from at least one location for subsequent packing of the at least one bottle in the shipping container, and receiving the at least one bottle corresponding to the

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particular prescription order from a bottle removing mechanism and inserting the at least one bottle corresponding to the particular prescription order into the shipping container." In fact, none of these references disclose *anything* with regard to carriers containing prescription bottles. In this regard, and as noted above, the Examiner's assertion that that the carriers recited in the claimed invention correspond to the conveyors 24a, 24b, and 24c disclosed in Charhut cannot possibly be correct. If the Examiner believes Charhut, Bailer or Goldberg, alone or in combination, teach or suggest the step of "placing the one or more prescription bottles of each order in carriers, each carrier having a multiplicity of locations to receive prescription bottles" as recited in the claimed invention, he is requested to specify, by column and line number and/or Figure number, where such step and/or carriers are disclosed.

In addition, Charhut, Bailer or Goldberg, alone or in combination, do not teach or suggest "placing the one or more prescription bottles and a corresponding **customized** literature pack of each order in a container." Other features are also clearly absent from a cursory inspection of Charhut, Bailer and Goldberg. Finally, since several features are missing, the combination of features are also submitted to patentably distinguish over the prior art.

Applicants respectfully submit that dependent claims 13-15 are not only allowable by virtue of their dependency from independent claim 12, but also because of additional features they recite. Claims 14 recites that the "identifier is applied to each of the one or more bottles prior to filling said prescription bottles with pills," which is not taught or suggested by Charhut, Bailer or Goldberg, alone or in combination.

In view of the above, Applicants submit that the combination of features recited in each of claims 12-15 is patentable over the prior art cited by the Examiner when each respective claim is interpreted as a whole. Accordingly, Applicants request that claims 12-15 be passed to issue.

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Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present

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claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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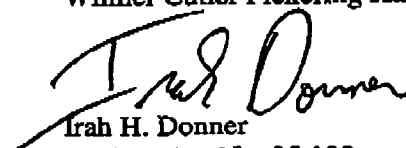
PATENTAUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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